

Appl. No. : 09/986,078
Filed : November 7, 2001

REMARKS

Claims 1, 7, 11, 19 and 33 have been amended by this paper. Claims 10, 13 and 17 were previously cancelled without prejudice. Claims 2-6, 8-10, 12-18 and 20-32 remain unchanged by this Amendment. Hence, by this paper, Claims 1-9, 11, 12, 14-16 and 18-33 are presented for further examination.

In the Office Action mailed November 3, 2004, Claims 1-9, 11, 12, 14-16 and 18-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Margrey et al. (U.S. Patent No. 6,192,320, hereinafter “Margrey”) in view of Gordon (U.S. Patent No. 6,476,907, hereinafter “Gordon”).

Applicant respectfully notes that each of the independent claims presented herein is directed to the use of bio-disc authentication information. This bio-disc authentication information is discussed in the specification at, for example, page 4, line 18 – page 5, line 4, wherein it states that:

In another preferred embodiment, the bio-disc also includes special markings or encoding, such as a serial number, which identifies the bio-disc as an authentic, authorized, or approved bio-disc meeting certain standards. In combination therewith, the processing and control software on the server may be enabled to remotely verify whether the bio-disc is authorized. After authenticity is verified, subsequent processing of the biological sample on the bio-disc is allowed. In the event control and processing software on the server determines that the bio-disc is not authentic, *i.e.*, a counterfeit, the control software will prevent processing of the biological sample on the disc. In this manner, a desired level of user security is thus implemented in the system.

In his “Response to Arguments” in the Office Action mailed November 4, 2004, the Examiner stated that “Gordon does disclose a bio-disc having bio-disc information.” The Examiner identifies several locations in Gordon in support of this representation. For example, at column 3, lines 36-39, Gordon refers to “a disc comprising a plastic base layer on the upper surface of which is formed a plurality of perturbations . . . representing digitally encoded data . . .”. At lines 56-58, Gordon states that “the disc comprises a lower layer of transparent plastic on the surface of which is impressed, or otherwise produced, said digital information.” At column 2, lines 31-35, Gordon refers to the substrate “being provided with distributed electromagnetic radiation modulating means for modulating at least a part of said beam with a digitally encoded position address indicative of the location on said surface on which the beam is currently directed.” (Emphasis added). Also, at column 6, lines 24-25, Gordon notes that it “is

Appl. No. : 09/986,078
Filed : November 7, 2001

possible to use this same technique to digitally encode position information into the disc of FIG. 1.” (Emphasis added).

Applicant respectfully submits that Gordon teaches the inclusion of digitally encoded data for purposes such as providing position information, as indicated at the locations identified by the Examiner. However, there is neither any teaching nor any suggestion in Gordon of bio-disc authentication information, which may be used to verify authenticity of the bio-disc, as is accomplished by the structure of independent Claims 1 and 19, and by the method as defined in independent Claims 7, 11, 15 and 33. Merely because the Gordon reference discloses the provision of embedded data for use in operation of the disc does not reasonably provide a basis for determining it to be obvious to provide bio-disc authentication information, as included in Applicant’s claims the bio-disc authentication information of Applicant’s invention is entirely different from, and used for an entirely different purpose than, the data disclosed in Gordon.

The Examiner goes on to say that Margrey “discloses a node . . . configured to evaluate the bio-disc information so as to verify authenticity” (Margrey et al., col. 9, lines 52-60 “error checking”). However, as the Examiner himself pointed out, the indicated teachings relate to “error checking.” In particular, at column 9, lines 61-62, Margrey states that “if the interface detects an instrument operational error, the error mode is indicated.” The identification of errors in Margrey is important to the operation of that system, which is “an interactive multi-station medical specimen analysis system for simultaneously analyzing a medical specimen at remote locations and accessing for evaluation the results of each of the analyses at a central laboratory . . .” (col. 4, lines 43-46). In describing the operating system and server, Margrey states that “this arrangement maintains complete instrument functionality as designed by the manufacturer while allowing remote monitoring and operation of the instrument” (col. 9, lines 11-14). Thus, it is readily apparent that the identification of errors in instrument operation is critical to the proper functioning of the Margrey system. However, the “error checking” disclosed in Margrey in no way relates to the provision or use of authentication information as defined by Applicant’s claims. Whether or not an error is detected in Margrey has no relation to any aspect of authorization, nor is there any suggestion in Margrey as to the applicability of such error checking to authorization, as defined by Applicant’s claims.

In view of the above, Applicant respectfully submits that Gordon neither teaches nor suggests at least the claim limitations indicated above, including the provision of bio-disc

Appl. No. : **09/986,078**
Filed : **November 7, 2001**

authentication information, or the evaluation of such bio-disc authentication information so as to verify authenticity of a bio-disc. Furthermore, Applicant notes that Margrey neither teaches nor suggests at least the features discussed above, as presented in Applicant's independent claims. Thus, since there is an absence of the teaching or suggestion of these features in both Gordon and Margrey, Applicant respectfully submits that the combination of those references can neither teach, nor would they have made obvious the subject matter of independent Claims 1, 7, 11, 15, 19 and 33. Furthermore, since Claims 2-6, 8, 9, 12, 14, 16, 18 and 20-32 each depend from one of independent Claims 1, 7, 11, 15 or 19, Applicant submits that these claims also are patentable over the Gordon and Margrey references, for at least the reasons set forth above.

In his Response to Arguments, the Examiner also again stated that "one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references." Applicant again notes that the response to the Office Action mailed October 13, 2004 did not "attack references individually" to overcome the obviousness rejections. Rather, Applicant merely pointed out the lack of teaching or suggestion in the references individually, so that it is made clear that the combination of the two references also neither teaches nor suggests the referenced claim features. Applicant notes that the Examiner himself discusses various features of Gordon and of Margrey individually in order to attempt to establish that the combination would teach obviousness. Accordingly, although Applicant has necessarily described the references individually, Applicant has pointed out and does again submit that the combination of the Gordon and Margrey references does not provide any teaching or suggestion which have rendered the claims presented herein obvious.

In view of the above, Applicant respectfully submits that Claims 1-9, 11, 12, 14-16 and 18-33 are patentable over the art of record. Accordingly, Applicant respectfully submits that these pending claims are now in condition for immediate allowance and such prompt allowance of the same is respectfully requested.

CONCLUSION

The Applicant has endeavored to address all of the concerns of the Examiner in view of the recent Office Action directed to the above-identified application. Accordingly, amendments to the claims, the reasons therefor and arguments in support of the patentability of the pending claims are presented above.

Appl. No. : 09/986,078
Filed : November 7, 2001

Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. Any new claims presented above are of course intended to avoid the prior art, but are not intended as replacements or substitutes for any cancelled claims. They are simply additional specific statements of inventive concepts described in the application as originally filed.

In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Jan. 31, 2005

By:



Drew S. Hamilton
Registration No. 29,801
Attorney of Record
Customer No. 20,995
(619) 235-8550

AMEND
S:\DOCS\DSH\DSH-5012.DOC
012805